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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,651	09/24/2003	Jim Jones	20470.066	6788

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EXAMINER

HEWITT, JAMES M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,651

Applicant(s)

JONES, JIM

Examiner

James M Hewitt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-15 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/24/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Figures 1-6;

Species II: Figures 7-8.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Charles Gunter on 4/14/04 a provisional election was made without traverse to prosecute the invention of Species I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of copending

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Application No. 10/440,809. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Regarding claim 7, claim 16 includes all the limitations thereof.

Regarding claim 8, the recitation "at least one row of teeth..." in claim 16 is considered to be inclusive of a plurality of row of teeth, as claimed in claim 8.

Regarding claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the acute angle in the range of 5 and 20 degrees, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 10, the recitation of plastic pipe in claim 16 is considered to be inclusive of PVC pipe as PVC is a commonly used plastic pipe. Or, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use PVC pipe, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

Claims 4, 10, 11 and 14 are objected to because of the following informalities:

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In claim 4, the phrase "plastic pipe is" should be replaced with "male and female plastic pipes are".

In claim 10, the phrase "plastic pipe is" should be replaced with "male and female plastic pipes are".

In claim 11 line 4, the period should be replaced with a comma.

In claim 14 line 1, the teeth are never said to form the acute angle. Rather claim 12 recites that the inner circumferential surfaces of the ring segments form the acute angle. Claim 14 should be amended to rectify this.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (US 5,464,228).

With respect to claim 1, Weber et al discloses a self-restrained pressure gasket for insertion within an annular groove provided in a bell end (1) opening of a female pipe (2) capable of both joining and sealing the female pipe to a mating male pipe (4) having an interior surface and an exterior surface, the gasket (6) comprising: an annular gasket body made of a resilient elastomeric material (24), the annular gasket body having an

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inner circumferential region and an outer circumferential region; a segmented ring formed of a plurality of hardened ring segments (34) integrally molded within the material of the gasket body so that the ring segments are at least partially embedded within the resilient elastomeric material, each of the ring segments having an inner circumferential surface, an outer circumferential surface, front and rear end faces and opposing sides, at least one row of teeth (36, 38, 40) located on the inner circumferential surface of at least selected ones of the ring segments for engaging selected points on the exterior surface of the mating male pipe; wherein the ring segments are located within the annular gasket body with the inner circumferential surfaces thereof forming an acute angle with respect to the inner circumferential region of the gasket and with respect to the exterior surface of the mating male pipe (refer to Figures 1 and 2). Weber et al states that his gasket is for use with ductile iron pipe. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ his gasket with a plastic pipe, such as PVC, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 2, wherein a plurality of rows of teeth are located on the inner circumferential surface of at least selected ones of the ring segments.

With respect to claim 3, wherein the acute angle which is formed between the inner circumferential surface of the ring segments and the inner circumferential region of the gasket is in the range from about 5 to 20 degrees. Refer to Figure 2.

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With respect to claim 4, refer to the above rejection of claim 1.

With respect to claim 5, wherein the end faces of the ring segments protrude slightly from the resilient elastomeric material of the gasket body.

With respect to claim 6, wherein two parallel rows of teeth are located on the inner circumferential surface of at least selected ones of the ring segments, at least one of the rows of teeth being initially exposed from the resilient elastomeric material of the gasket body.

With respect to claim 12, Weber et al discloses a method of joining and sealing a female pipe (2) to a mating male pipe (4) having an outer pipe surface, the method comprising the steps of: providing an annular gasket (6) having an annular gasket body made of a resilient elastomeric material (24), the annular gasket body having an inner circumferential region and an outer circumferential region, the gasket body also having a segmented ring formed of a plurality of hardened ring segments (34) integrally molded within the material of the gasket body so that the ring segments are at least partially embedded within the resilient elastomeric material, each of the ring segments having an inner circumferential surface, an outer circumferential surface, front and rear end faces and opposing sides; wherein at least one row of teeth (36, 38, 40) is located on the inner circumferential surface of at least selected ones of the ring segments for engaging selected points on the exterior surface of the mating male pipe; wherein the ring segments are located within the annular gasket body with the inner circumferential surfaces thereof forming an acute angle with respect to the inner circumferential region of the gasket (see Figures 1 and 2); inserting the gasket body into an annular groove

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provided within a bell end opening (1) of the female pipe; inserting the mating male pipe into the bell end opening of the female pipe with the male and female pipes being aligned along a central axis with at least selected teeth of the hardened ring segments being initially angled away from the outer surface of the male plastic pipe, the teeth of the annular gasket being forced into engagement with the exterior surface of the male plastic pipe as the pipe joint is assembled, the teeth being oriented to allow movement of the male pipe in a first direction relative to the female bell end opening but to resist movement in a opposite direction.

With respect to claim 13, wherein a plurality of rows of teeth are located on the inner circumferential surface of at least selected ones of the ring segments.

With respect to claim 14, wherein the acute angle which is formed between the teeth of the ring segments and the outer surface of the plastic pipe is in the range from about 5 to 20 degrees. Refer to Figure 2.

With respect to claim 15, wherein the ring segments have opposing front and rear end faces and wherein the rear end faces of the ring segments protrude slightly from the resilient elastomeric material of the gasket body.

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peting et al (US 5,037,144) in view of Weber et al (US 5,464,228).

With respect to claim 7, Peting et al discloses a pipe joint comprising: a female pipe having a bell end opening with an annual groove (defined between the pipe opening and wall 20) for receiving a sealing gasket, the bell end opening being sized to

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receive the spigot end (12) of a mating male pipe having an interior surface and an exterior surface; a self-restrained pressure gasket (34) located within the annular groove provided in the bell end opening of the female pipe capable of both joining and sealing the female pipe to the male pipe, the gasket comprising: an annular gasket body (36), the annular gasket body having an inner circumferential region and an outer circumferential region; a segmented ring (segments 38) formed of a plurality of hardened ring segments secured within the gasket body, each of the ring segments having an inner circumferential surface, an outer circumferential surface, front and rear end faces and opposing sides; at least one row of teeth (40) located on the inner circumferential surface of at least selected ones of the ring segments for engaging selected points on the exterior surface of the mating male pipe; wherein the ring segments are located within the annular gasket body with the inner circumferential surfaces thereof forming an acute angle with respect to the inner circumferential region of the gasket and with respect to the exterior surface of the mating male pipe; and a circumferential gland fitting (31) sized to be received about the outer surface of the mating male pipe, the gland fitting having a forward lip region which contacts and compresses the gasket body as the joint is assembled.

Peting et al fails to teach that the male and female pipes are plastic pipes. Peting et al employs ductile iron as the material for the male and female pipes. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ plastic pipe, such as PVC, since it has been held to be within the general skill of a worker in the art to select a known material on the

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basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Although it is unclear the material of the gasket body (36), it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an elastomer as the material of the body, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Peting et al fails to teach that the ring segments are integrally molded within the material of gasket body. Peting et al states that the locking segments are fastened within the body (36). Weber et al teaches a bell and spigot joint employing a gasket body for sealing the two pipes. The gasket body comprises a plurality of metal retaining elements that are integrally molded and embedded within the elastomeric gasket body. In view of Weber's teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to integrally mold Peting's locking segments within his gasket body as taught by Weber et al in order to more securely fasten and retain the locking segments within the gasket body.

With respect to claim 8, wherein a plurality of rows of teeth are located on the inner circumferential surface of at least selected ones of the ring segments.

With respect to claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the acute angle in the range of 5 and 20 degrees, since it has been held that where the general conditions of a claim are

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disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With respect to claim 10, refer to the above rejection of claim 7.

Allowable Subject Matter

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Note that the allowability of claim 11 is also contingent on overcoming the above-noted objection to claim 11. See ***Claim Objections*** above.

Conclusion

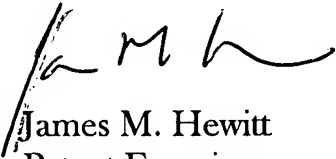
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M Hewitt whose telephone number is 703-305-0552. The examiner can normally be reached on M-F, 930am-600pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J M H', is positioned above the printed name.

James M. Hewitt
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